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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,483	11/26/2003	Andrew Robert Penman	10286.0320.CPUS02	9532
23369	7590	12/15/2005	EXAMINER	
HOWREY LLP			HONG, JOHN C	
C/O IP DOCKETING DEPARTMENT			ART UNIT	
2941 FAIRVIEW PARK DRIVE, SUITE 200			PAPER NUMBER	
FALLS CHURCH, VA 22042-7195			3726	

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/723,483

Applicant(s)

PENMAN ET AL.

Examiner

John C. Hong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-63 is/are pending in the application.  
4a) Of the above claim(s) 55 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-29 is/are allowed.
- 6) ☒ Claim(s) 30,44,56 and 63 is/are rejected.
- 7) ☒ Claim(s) 31-43,45-54,57-62 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All / b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/2/04;4/26/04;3/28/05 : 6/7/04

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of claims 1-54 and 56-63 in the reply filed on 9/27/05 is acknowledged.

***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "120" has been used to designate both inner latch and outer latch; and reference character "130" has been used to designate both inner latch and outer latch . Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claim 63 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 63 line 5, 'the pin end' lacks antecedent basis.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 30 and 44 are and rejected under 35 U.S.C. 102(b) as being anticipated by Smith, Jr. et al. (U.S. Patent 4603464).

Smith, Jr. et al. discloses: Regarding Claim(s) 30, an apparatus for making up jointed pipe with threaded connections comprising: a means (19) for gripping a first joint (27) of pipe to prevent rotation thereof, a spinner means (29) having one or more drive wheels operable to rotationally make-up a threaded connection between a second joint (23) of pipe and the first joint of pipe to an initial make-up torque, a means (35) for applying a retaining force to the second joint of pipe to maintain the second joint of pipe in rotational contact with the drive wheels of the spinner means, and a second means (17) for gripping the second joint of pipe and operable to apply a final make-up torque to the threaded connection (Fig. 1; col. 2, lines 19-50); and Regarding Claim(s) 44, a method for making up jointed pipe having threaded connections comprising: gripping a first joint (27) of pipe with a first gripping means(19) to prevent rotation

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thereof, applying a retaining force to a second joint (23) of pipe to maintain the second joint of pipe in contact with one or more drive wheels on a spinner means (29), making up a threaded connection connecting the second joint of pipe to the first joint of pipe to an initial make-up torque with the spinner means, and applying a final make-up torque to the threaded connection connecting the second joint of pipe to the first joint of pipe with a second gripping means (17), wherein the first and second gripping means and the spinner means are components of a single apparatus (Fig. 1; col. 2, lines 19-50).

7. Claim 56 is rejected under 35 U.S.C. 102(b) as being anticipated by Haby (U.S. Patent 3902385).

Haby discloses: an apparatus for making up jointed pipe with thread connections comprising: a pair of gripping members (20,21) for gripping a joint of pipe; a remotely operated latching mechanism (39) for connecting the gripping members, the latching mechanism comprising: an inner latch (40), an outer latch (46), and a latch pin (47) selectively moveable between an open position and a closed position, wherein in the closed position the pin secures the inner and outer latches together (Figs. 1,4 and 9; col. 3, line 8-clo. 4, line 8).

***Allowable Subject Matter***

8. Claims 1-29 are allowed.


9. Claims 31-43, 45-54 and 57-62 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John C. Hong whose telephone number is 571-272-4529. The examiner can normally be reached on M-F(07:00-16:30)First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on 571-272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John C. Hong  
Primary Examiner  
Art Unit 3726

jh  
December 11, 2005